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EMC-012

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Inventors:	Silvestro et al.
Appln No:	10/812,266
Atty.:	Michael Rodriguez
Filing Date:	March 29, 2004



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Application Number

10/812,266

Filing Date

March 29, 2004

First Named Inventor

Silvestro

Art Unit

3677

Examiner Name

Flemming Saether

Attorney Docket Number

EMC-012 (EMC-04-014)

ENCLOSURES (Check all that apply)☐

Fee Transmittal Form

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Fee Attached

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Amendment/Reply

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After Final

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Affidavits/declaration(s)

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Extension of Time Request

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Express Abandonment Request

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Information Disclosure Statement

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Certified Copy of Priority Document(s)

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Incomplete Application☐Reply to Missing Parts
under 37 CFR 1.52 or 1.53☐

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of Appeals and Interferences☒Appeal Communication to TC
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Guerin & Rodriguez, LLP

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Michael A. Rodriguez

Date

2/15/06

Reg. No.

41,274

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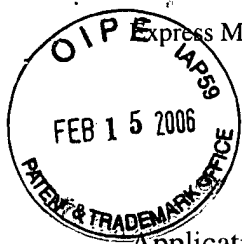
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.: 10/812,266
Applicants: Silvestro et al.
Filing Date: March 29, 2004
Art Unit: 3677
Examiner: Flemming Saether
Confirmation No.: 2765
Title: Fastener for Use in Securing Side Rails to Round Hole and Square
Hole Mounting Rails of Cabinet Racks

CERTIFICATE OF MAILING

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Michael A. Rodriguez

Date: February 15, 2006

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REPLY BRIEF UNDER 37 C.F.R. § 41.41

In response to the Examiner's Answer, dated December 15, 2005, appellants hereby submit this Reply Brief.

REPLY ARGUMENTS TO EXAMINER'S ANSWER

In arguing claim 1, the Examiner states in the third paragraph of the section (10) of the Answer: “*As with the instant invention*, the novelty of Drake over the prior art is in the location portion and not in the fact that it is a cage nut.” [Emphasis added.] Appellants submit that this statement is imprecise. In the second paragraph, the Examiner concedes that the applicants’ claims are unique, and yet this concession is certainly not because the applicants’ claims recite a stepped portion. The remainder of the Examiner’s answer attests to that. No, the applicants’ claims are unique because of the combination of the stepped portion with a screw. Despite the Examiner’s contention that it is not, the applicants’ invention is a screw, a screw in combination with a particular feature, i.e., the stepped portion. Granted, a similar feature already appears in the prior art (namely, Drake’s locating surface), but not in combination with a screw.

Also in the third paragraph, the Examiner indicates that the applicants’ application relies on the stepped portion for distinguishing over the prior art. This statement is imprecise, too. If the applicants’ application relied on the stepped portion alone for distinguishing over the prior art, then the Examiner should have issued a 102 rejection. No, the applicants’ application does not rely on the stepped portion alone, but on the combination of the stepped portion with a screw, a combination neither shown nor suggested in the prior art. Prior art screws alone do not suggest the combination, nor does Drake’s caged nut – rather, the suggestion for this combination comes only from the applicants’ application.

In addition, the Examiner asserts that the locating surface is the crux of Drake’s invention and Drake’s point of novelty over the prior art. Perhaps this is so. By making this assertion, however, the Examiner reveals two underlying premises that lead to an improper conclusion: (1) because Drake’s locating surface was the key to Drakes’ patentability, therefore the applicants’ stepped portion must be the key to the patentability of the applicants’ application; and (2) because Drake’s location portion came first, the applicants did not invent the stepped portion; with the improper conclusion being that because someone else has invented the applicants’ key to patentability, the applicants’ invention is obvious. In reply, first the appellants reiterate that the stepped portion alone is not the key to patentability, but the combination of the stepped portion with a screw is the key – thus the first premise is flawed. Secondly, Drake’s invention of a locating surface does not render obvious all

other combinations that also use the locating surface. If this were the case, what then could be patented? Are not many patented inventions the combination of previously “invented” elements?

In the appellants’ Appeal Brief, appellants argued that the simplicity of the applicants’ invention is being confused with obviousness. In reply, the Examiner’s contends that it is the simplicity that leads to obviousness. This is precisely the appellants’ point, except that the Examiner has deftly redirected the appellants’ argument to the simplicity of Drake’s cage nut. This gets to the heart of this particular point of contention: is this a hindsight rejection because of the simplicity of the applicants’ screw or is this obviousness because of the simplicity of Drake’s cage nut? The appellants contend that a comparison of the simplicity of the applicants’ screw with that of the Drake’s cage nut would favor the relative simplicity of the applicants’ screw. Drake’s cage nut seems anything but simple as far as cage nuts go. Notwithstanding, to support the assertion of Drake’s simplicity, the Examiner cites a boilerplate remark, the kind made by patent drafters who want to prevent others from narrowly limiting the scope of the claims to only those embodiments disclosed within the patent. To assert that this boilerplate remark is Drake’s recognition of the simplicity of the art is to read something into the remark that just is not there. As the Examiner may know first hand, similar statements as this boilerplate remark can be found in many patents for inventions that are far more complex than what Drake describes. Simply because the “generic principles herein may be applied to other embodiments” does not necessarily make those generic principles simple.

The Examiner contends that Drake and the applicants’ invention arrived at the same solution, because Drake’s cage nut and the applicants’ screw have a locating surface and a stepped portion, respectively, and because both types of hardware (i.e., the cage nut and screw) solve the same problem. Certainly one cannot contend that the cage nut and screw are identical solutions – otherwise the cage nut would function in the same way as the screw. However, this is clearly not the case – aside from the fundamental structural differences between a cage nut and a screw, the cage nut functions to receive a threaded screw, whereas the screw functions to enter a threaded nut. And there are definite advantages to the use of screws over cage nuts, several of which are described in the appellants’ Appeal Brief – a point with which the examiner agrees, granted, if used with “certain rails”). Thus, the applicants have devised a different solution – yes, the solution is a screw with a

particular feature, a solution with real advantages over the cage nut, advantages unappreciated by and non-obvious in view of Drake.

The Examiner points out that Drake need not disclose all possible embodiments which would benefit from the “generic principles” disclosed therein. Agreed. However, the appellants contend that the Examiner is taking unwarranted liberty to assert that “Clearly, Drake does intend to limit ... another of [sic] embodiment of the “generic principles” would be [sic] to a screw since, as disclosed by the appellants, a screw is commonly used in the same application as the cage nut (paragraph [0003]).” The Examiner thus uses the applicants’ specification to divine Drake’s “clear” intention. Nonetheless, such an intention is anything but clear and certainly questionable when one has to go to a separate document, a document not written by Drake, to try to discern Drake’s intention. A more reliable practice is to use the four corners of Drake’s own patent to discern Drake’s intention. And the complete lack of mention in Drake of embodiments of screws with a locating surface would suggest that applying the “generic principles herein” to a screw is anything but Drake’s intention. Rather, a more fair interpretation is that the “generic principles” are for other embodiments of cage nuts.

In the ninth paragraph of section (10) of the Answer, the Examiner agrees that in some applications nuts and bolts would not be interchangeable. However, the Examiner does assert that the application of Drake is not one of those applications. To buttress this assertion, the Examiner points to the applicants’ own disclosure describing the well-known prior art use of nuts and bolts when mounting computer systems to racks. The appellants contend, however, that this is not evidence of their interchangeability. Rather, this is evidence of their complementary and cooperative use, i.e., the nut and screw work together to fasten the computer to the rack. Just because one can use nuts and bolts together when mounting computers to rails does not necessarily imply that the features of a nut can be used to modify a screw. Thus, the Examiner’s example fails to support the Examiner’s assertion that Drake’s application “is not one of those applications,” and the Examiner still has not provided any evidence that the applicants’ invention is of a particular kind for which interchangeability would be common knowledge.

Concerning separately argued claim 2, the Examiner argues that the square shape of Drake’s locating surface is a preferred shape, and leaves open the possibility of other shapes. However, the

mere possibility of other shapes does not make a circular shape obvious, as recited in applicants' claim 2, unless the prior art suggested the desirability of the modification. As argued in the appellants' Appeal Brief, the suggestion for a circular shape cannot come from Drake because a circular shape would bring undesirable results to Drake's cage nut. Thus, the suggestion for a circular shape can come only from the applicants' invention. Notwithstanding, the Examiner states that the rejection "is not looking to change the shape of the location portion on the nut to be circular, but, instead is modifying the location portion "*once combined with the screw*" [Emphasis added.] The rejection, therefore, is working backwards from the applicants' application, in effect making the applicants' combination and then stating that in view of the combination the circular shape is now obvious. The applicants' own combination is thus being used to render features of the applicants' claimed invention obvious. This is impermissible hindsight.

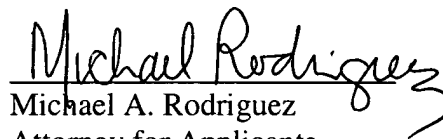
CONCLUSION

In view of the arguments made herein, appellants submit that the application is in condition for allowance.

Respectfully submitted,

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